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Ralph E. Jocke  
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March 26, 2003

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

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BOARD OF PATENT APPEALS  
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Re: **Application Serial No.:** 09/014,076  
**Confirmation No.:** 4092  
**Appellants:** McGrady, et al.  
**Title:** Method For Tracking And  
Dispensing Medical Items  
**Docket No.:** D-1056 DIV3

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated February 13, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 10-0637.

Very truly yours,

  
Ralph E. Jocke  
Reg. No. 31,029

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Ralph E. Jocke

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rej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



## **REMARKS**

The Examiner's Answer ("Answer") dated February 13, 2003 is acknowledged.

### **Initial Comments**

The Appeal Brief was filed March 7, 2001. Appellants are pleased that the Examiner has finally written an Examiner's Answer.

Appellants acknowledge that the rejections of claims 48-53 pursuant to 35 U.S.C. § 102(e) as being anticipated by Halvorson have been vacated.

Appellants also acknowledge that the rejections of claims 48-53 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Pearson '029 have been vacated.

### **Grouping of Claims**

The Answer (at pages 4 and 7), as best understood, alleges that claims 45 and 47 stand or fall together with claim 38, and that claims 50-51 and 53 stand or fall together with claim 49. Appellants respectfully disagree. The Answer acknowledges that the Appeal Brief includes a proper statement that the claims do not stand or fall together. Furthermore, separate arguments for claims 45 and 47 may be found, for example, in the Appeal Brief at pages 32 and 33, respectively. Separate arguments for claims 50-51 and 53 may be found, for example, in the Appeal Brief at pages 41 and 42, respectively.

### **The "Response to Argument" Section of the Answer**

#### **The 37 C.F.R. § 1.131 Declaration**

In the Answer at pages 16-17, the Examiner refers to Appellants' 37 C.F.R. § 1.131 Declaration filed August 30, 2000, with regard to Pearson '232 and Pearson '029. The Answer (page 16, lines 7-8) again confirms that the Declaration was accepted and entered by the Office. The Appeal Brief fully discusses the Declaration issue (with regard to Pearson '232 and Pearson '029) in detail beginning at page 15.

Pearson '232 does not constitute prior art. Pearson '232 is a continuation-in-part (CIP) of great-grandparent Pearson '029. Great-grandparent Pearson '029 does not teach the recited features of the pending claims (e.g., claim 38). This is evidenced by the Action itself, which does not include an anticipatory rejection of claim 38 based on Pearson '029. Thus, the Action admits, by inference, that great-grandparent Pearson '029 cannot anticipate claim 38. Pearson '232 does not anticipate the pending claims (e.g., claim 38). Nor can Pearson '232 rely on great-grandparent Pearson '029 for subject matter of the pending claims (e.g., claim 38).

Also, Pearson '232 cannot rely on the filing date of Pearson '029 for the subject matter which is alleged to anticipate the pending claims (e.g., claim 38). Pearson '232 contains new subject matter (not found in Pearson '029) to support the invention therein. This new matter was critical to the issued Pearson '232. Thus, Pearson '232 is not entitled to the filing date of great-grandparent Pearson '029 as a 35 U.S.C. § 102(e) date (MPEP § 2136.03). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981). The Declaration swears behind the (newer) CIP subject matter of Pearson '232. It follows that Pearson '232 does not constitute prior art.

Furthermore, subject matter which is disclosed in a parent Application (Pearson '029) but not included in the child CIP (Pearson '232) cannot be relied on in a 35 U.S.C. § 102(e) rejection applying the issued CIP (MPEP § 2136.02). *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). Such is the current situation. The Office has presented no evidence of record that the subject matter (e.g., dispenser mechanism 35) relied upon in the parent patent (Pearson '029) is included in the child CIP (Pearson '232).

#### The Individual References

In the Answer at pages 17-21, the Examiner refers to individual references. Appellants respectfully submit that the Examiner's random comments (as best understood) regarding the individual references have already been addressed in the Appeal Brief.

#### Appeal Brief Sizes

The Examiner again returns to the issue of Appeal Brief sizes (Answer at pages 15-16). However, this issue was already decided in the Director's decision on petition (dated March 14, 2002), which agreed with Appellants that the Examiner was in clear error. The issue was a "petitionable matter." The Examiner cannot appeal the Director's decision to the Board of Patent Appeals and Interferences. That is, the Director's decision is not an "appealable matter" (on behalf of the Examiner).

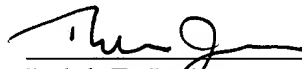
The Examiner's comments in the Answer at page 16, lines 1-2 are without merit. These comments are reflective of all the baseless rejections in the Answer, as shown in more detail in the Appeal Brief. Appellants request that the Office strike said comments from the record, and

that proof of such act be presented to Appellants. Contrarily, without Appellants' requirement to respond to each of the unnecessary cumulative rejections (which are in violation of MPEP § 706.02), the Appeal Brief size probably would have appeased the Examiner's self-created new rules.

### CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

  
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Ralph E. Jocke  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029